

REMARKS

This paper is presented in response to the Office Action. By this paper claims 1-13 and 15-25 are amended. Accordingly, claims 1-13 and 15-25 remain pending.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

I. General Considerations

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and any references cited by the Examiner, and/or the merits of additional or alternative arguments.

II. Objection of Claims 1-13 and 15-25

The Examiner has objected to claims 1-13 and 15-25 because of an informality. Applicant respectfully disagrees, but submits that in light of amendments made herein to claims 1-13 and 15-25, the objection has been overcome and should be withdrawn.

III. Rejection of Claims 1-13 and 15-25 under 35 U.S.C. § 103

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

a. Rejection based on *Nosu* and *Yamauchi* combination

The Examiner has rejected claims 1-13, 15, and 18-25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,244,045 to *Nosu* et al. (“*Nosu*”) in view of U.S. Patent No. 7,038,778 to *Yamauchi* (“*Yamauchi*”). Applicant respectfully disagrees, and submits that for at least the reasons set forth below, the rejection of claims 1-13, 15, and 18-25 should be withdrawn. Of the rejected claims, claims 1, 23 and 24 are independent claims.

i. claims 1-13, 15, 18-22, and 25

With regard to independent claims 1, the Examiner concedes that *Nosu* fails to teach an optoelectronic transducer “supported by a substrate,” and “a lens attached to the substrate,” as recited in claim 1. The Examiner then cites *Yamauchi* for teaching “an optical transducer mounted on a substrate (15) that includes a lens attached to the substrate (11),” and that “[i]t would have been obvious ... to recognize the device would be more usable when housed on a substrate that can be easily handled,” and “to recognize a need for a lens to condense the optical source into the transducer for the optical signal to be efficiently coupled into the transducer.”

With respect to the purported motivation for the allegedly obvious combination of *Nosu* and *Yamauchi*, Applicant notes that the Examiner has asserted that it would have been obvious to add a substrate to *Nosu* “for better handling,” and that it would have been obvious to have a lens attached to the [substrate] housing “to collimate light from the source integrated in the housing into the transducer.” *Emphasis added*. Applicant notes however that “better handling” is a relative term whose definition is known only to the Examiner. For example, it is not at all apparent what reference point(s), if any, the Examiner is using as a basis to assert that handling would necessarily be “better” as a result of the purportedly obvious combination. For at least this reason, Applicant submits that the Examiner has failed to establish the existence of a suggestion or motivation to make the purportedly obvious combination.

Additionally, the Examiner has failed to establish that the *Nosu* device suffers from such shortcomings as could, or would, be remedied by the *Yamauchi* disclosure. In the absence of any evidence that the *Nosu* device is somehow deficient in terms of its handling or light collimating, Applicant submits that the Examiner has failed to establish the existence of the requisite motivation to make the purportedly obvious combination.

Furthermore, as noted above it appears that the Examiner has asserted that element 15 of *Yamauchi* corresponds to the substrate recited in claim 1.¹ Notwithstanding this assertion, Applicant respectfully submits that the disclosure of *Yamauchi* does not support this assertion. For example, element 15 is disclosed in *Yamauchi* simply as corresponding to “a casing (cylindrical body)” in which components used to construct a spectroscopic instrument 1 “are housed.” Col. 4, lines 26-28. Applicant can find no disclosure in *Yamauchi* that this casing corresponds to a substrate. In fact, Applicant can find no mention within *Yamauchi* of an optical transducer mounted on or associated with a substrate, contrary to the assertion of the Examiner.

In contrast, and as noted above, claim 1 requires, among other things, “an optoelectronic transducer supported by a substrate,” and “an associated optical system that includes a lens attached to the substrate.” In view of the foregoing, Applicant submits that the Examiner has not established that *Nosu* or *Yamauchi* or any other reference teaches or suggests the aforementioned limitations in combination with the other limitations of claim 1.

In view of the foregoing discussion, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 1, at least because the Examiner has failed to establish the existence of a suggestion or motivation to make the purportedly obvious combination and because the Examiner has failed to establish that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of claim 1. Accordingly, Applicant respectfully submits that the rejection of claim 1, as well as the rejection of corresponding dependent claims 2-13, 15, 18-22, and 25, should be withdrawn.

ii. claims 23-24

Applicant notes that in rejecting independent claims 23 and 24, the Examiner refers *only to elements recited in claim 1* and has failed to specifically address a number of the elements recited in independent claims 23 and 24. Particularly, the Examiner has failed to even assert, much less establish, that *Nosu* or *Yamauchi* or any other reference teaches all of the limitations of those claims. For example, claim 23 requires, among other things:

¹ Although in the rejection the Examiner has apparently equated separate elements 11 and 15 to the substrate of claim 1, it appears that the Examiner meant to equate element 11 to the lens instead of the substrate. If this reading is incorrect, please advise accordingly.

- “a monolithic transparent body having first and second parallel surfaces,”
- “... a lens ... defining an associated optical axis aligned at an oblique angle relative to the second surface,” and
- “a plurality of wavelength-selective filters, each wavelength-selective filter being mounted between the second surface and a corresponding subassembly of the plurality of subassemblies,”

and claim 24 requires, among other things:.

- “a monolithic transparent body having first and second parallel surfaces,”
- “a coupling assembly mounted to the first surface of the monolithic transparent body, the coupling assembly defining a first optical axis aligned at an oblique angle relative to the first surface,”
- “...each subassembly ... including an associated optical system, each associated optical system defining an associated second optical axis that is aligned at the oblique angle relative to the second surface, the optical system comprising a lens formed on or in the substrate,” and
- “a plurality of wavelength-selective filters, each wavelength-selective filter being mounted between the second surface and a corresponding subassembly of the plurality of subassemblies, the plurality of wavelength-selective filters being positioned along the second surface such that a light beam pencil directed along the first optical axis is reflected between the first and second surfaces to each of the plurality of wavelength-selective filters.”

However, the Examiner has not even asserted, much less established, that *Nosu* or *Yamauchi* or any other reference discloses the aforementioned limitations in combination with the other limitations of claims 23 and 24.

In view of the foregoing discussion, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 23 and 24, at least because the Examiner has failed to establish that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of claims 23 or 24. Accordingly, Applicant respectfully submits that the rejection of claims 23 and 24 should be withdrawn.

b. Rejection based on *Nosu* and *Sasaki* combination

The Examiner has rejected claims 16 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Nosu* in view of U.S. Patent No. 5,960,141 to Sasaki et al. (“*Sasaki*”). Applicant respectfully disagrees,

and submits that for at least the reasons set forth below, the rejection of claims 16 and 17 should be withdrawn.

Claims 16 and 17 depend from claim 1. By virtue of their dependence from independent claim 1, dependent claims 16 and 17 each require, among other things, “an optoelectronic transducer supported by a substrate,” and “an associated optical system that includes a lens attached to the substrate.” As discussed at III(a). above, however, the Examiner has failed to establish that this limitation, in combination with the other limitations of the rejected claims, is taught or suggested by *Nosu* or *Yamauchi* or any other reference(s). *Sasaki* is cited for allegedly teaching a “leadframe that provides at least partially encapsulated potting compound mounted thereon...” As such, the Examiner has not established that *Sasaki* cures the deficiencies of *Nosu* with regards to claim 1, discussed above. Thus, even if *Nosu* is combined with *Sasaki* in the allegedly obvious manner set forth in the Office Action, the resulting combination nonetheless fails to include all the limitations of the rejected claims.

In view of the foregoing discussion, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 16 and 17, at least because the Examiner has failed to establish that the references, when combined in the purportedly obvious fashion, teach or suggest all the limitations of claims 16 or 17. Accordingly, Applicant respectfully submits that the rejection of claims 16 and 17 should be withdrawn.

CONCLUSION

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-13 and 15-25 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 9th day of October 2006

Respectfully submitted,

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